

Remarks

Claims 10-20 have been indicated to recite patentable subject matter. Applicant appreciates the recognition of patentable subject matter in the present invention.

Claims 23-25 are added and claims 10-12 have been canceled. Claims 1-9 and 13-25 are pending in the present application. Claims 1-5, 7-8, and 21-22 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 5,692,073 to Cass. Claim 6 stands rejected under 35 U.S.C §103(a) over Cass in view of U.S. Patent No. 5,913,542 to Belucci et al. and further in view of U.S. Patent No. 6,203,069 in view of Outwater et al. Claim 9 stands rejected under 35 U.S.C §103(a) in view of over Cass in view of U.S. Patent No. 6,249,716 to Edens et al.

Applicant respectfully traverses the rejections and requests allowance of all pending claims.

Referring to the rejection of claim 1, Applicant again respectfully asserts that Cass fails to disclose or suggest positively-recited limitations of claim 1 and such claim is allowable. Claim 1 positively-recites storing a first communication as data in a database, *changing the first communication on a substrate to form a second communication*, and *storing the second communication in the database*. The limitations of claim 1 are not shown nor suggested by the prior art and claim 1 is allowable for at least this reason.

Cass is devoid of any teaching or suggestion of changing a communication which is stored *in a database* and storing the *changed communication in the database* as claimed. Further, the teachings identified by the Office fail to disclose or suggest the claimed changing and storing.

More specifically, page 3 of the Office Action recites teachings in col. 8, lines 20-53 as allegedly disclosing the claimed storing the second communication in the database. The recited teachings fail to disclose or suggest the claimed storing of claim 1. Referring to the recited teachings of Cass, such discloses that a user marks paper providing a marked document instance which is a copy, printout or other rendering of a known document for which an original or other reference version has been stored *in a database or other collection of documents present*

*somewhere in system 10. The collection is stored in mass storage 109, database server 40 or on a Web server 50.*

In contrast, the identified teachings of Cass disclose storage of the marked document instance in *memory 106* which is available to processor 105 to generate an index into the stored collection of documents from which an image of the corresponding stored reference document is retrieved and made available to the processor.

It is clear that such teachings regarding storage of the marked document instance in memory 106 fail to disclose or suggest storage of the marked document instance in the database or other collection of documents disclosed to be stored in mass storage 109 or servers 40, 50. First, the marked document instances are only disclosed as being stored in memory 106 comprising a different physical device than the mass storage 109 or servers 40, 50 which are used to store the database as clearly disclosed in Cass. Accordingly, Applicant questions how the teachings of Cass may be interpreted to disclose the claimed storage of the second communication in the database when Cass positively discloses storage of the marked document instance in a different physical location than the storage of the database. The Office Action fails to provide an explanation as to how storage in a different physical entity (i.e., memory instead of the database in 40, 50, 109 of Cass) with no disclosed association of the memory with the mass storage devices or servers used to implement the database in Cass is to be considered to disclose storage of the marked document instance in the database.

Further, the "response to arguments" section of the Office Action fails to illustrate that Cass discloses or suggests storage of a second (i.e., changed) communication within a database which also stores the first (i.e., original or reference) communication. On page 9 of the Action, the Examiner states that Cass teaches storage of a marked document instance. Applicant agrees. As mentioned above, however, Cass discloses storage in the memory which is not disclosed as being part of the database which is implemented using mass storage 109 or servers 40, 50.

The Action on page 9 further recites that Cass stores the marked document instance as a means for making available to the processor, information about active elements and *information used to generate an index into a stored collection of*

*documents.* Applicant submits that the marked document instance is only used to generate the index into the database (as mentioned by the Office) as distinguished from storage of the changed communication within the database. In no fair interpretation may generation of an index for a database using the changed communication be considered to disclose or suggest storage of the changed communication within the database. Positively-recited limitations of claim 1 are not shown nor suggested by the prior art and claim 1 is allowable for at least this reason.

In accordance with the MPEP and CFR, Applicant requests clarification of the rejection of claim 1 if such claim is not allowed. Applicant respectfully requests identification *in a non-final action* of elements which allegedly correspond to limitations of the claims in accordance with 37 C.F.R §1.104(c)(2). In particular, 37 C.F.R §1.104(c)(2) provides that *the pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.* Further, 37 C.F.R. §1.104(c)(2) states that the Examiner must cite the best references at their command. When a reference is complex or shows or describes inventions other than that claimed by Applicant, the particular teachings relied upon must be designated as nearly as practicable. The pertinence of each reference if not apparent must be clearly explained for each rejected claim specified. Applicant respectfully requests clarification of the rejections with respect to specific references and specific references teachings therein pursuant to 37 C.F.R. §1.104(c)(2) in a non-final Action if any claims are not found to be allowable.

In particular, Applicant requests that the Office identify in Cass which structure allegedly corresponds to the claimed database, and where it is disclosed that a changed communication is stored within the structure identified as allegedly disclosing the database. Cass clearly discloses that the database may be provided by mass storage 109 or servers 40, 50 but fails to disclose or suggest any storage of a changed communication within the database. To the contrary, Cass discloses that the database includes original or other reference versions of the documents and not modified or altered documents.

In the alternative to identification of teachings in the prior art, Applicant requests that the Examiner submit an affidavit in support of the rejection equating the mere storage of the marked document instance in memory 106 with storage

within the database of storage 109 or servers 40, 50. In particular, the art is devoid of disclosing limitations of Applicant's claims at least some of which have been identified above. The only source of the rejections may result from the personal knowledge of the Examiner. Applicant hereby requests identification of prior art which discloses claimed limitations not found in the references of record *or the submission of an affidavit* in support of any rejection of the claims in a *non-final Action*. "[A]ssertions of technical facts in areas of esoteric technology must always be supported by citation of some reference work" and "allegations concerning specific 'knowledge' of the prior art, which might be peculiar to a particular art should also be supported." *In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420-421 (CCPA 1970).

Applicant also resubmits that the 103 rejection of claim 1 fails to set forth a *prima facie* case of obviousness as set forth in the previous response. Any modification to Cass to provide storage of a changed communication within the database would result in an inoperable arrangement since the database of Cass is clearly disclosed as only comprising original/reference documents for comparison purposes and the modification of the database to include marked document instances in accordance with the Examiner's construction of the Cass teachings would render the database useless for comparing subsequently modified documents with a set of original/reference documents to provide the paper-based user interface of Cass.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Referring to claim 2, Cass fails to disclose that the changing of the first communication comprises removing a portion of the substrate having a portion of the first communication thereon. Claim 2 is allowable for at least this reason.

Applicants have electronically searched and have failed to uncover any "removal" teachings. Figs. 10-12 of Cass are relied upon on page 5 of the Action in support of the rejection of claim 2. The rejection is improper.

Applicant initially refers the Examiner to the teachings in col. 13, lines 65-68 wherein it is stated that test results are shown from reference-based mark

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extraction software. Fig. 10 is an original/reference document and Fig. 11 is a marked document instance which is a mark-up copy of the reference image and Fig. 12 shows the extracted marks.

Referring again to claim 2, the first communication is changed on the substrate to form the second communication and thereafter the second communication is scanned to digitize the second communication. The mark extraction of Fig. 12 is not disclosed anywhere in Cass as being provided upon media which is subsequently scanned. To the contrary, Cass is clear the processing of Figs. 10-12 is software processing which fails to show or suggest the removing of a portion of the second communication on the substrate as claimed. Claim 2 recites limitations which are not shown nor suggested by the prior art and claim 2 is patentable for at least this reason.

In the event that claim 2 is not allowed, Applicant respectfully requests identification of specific reference teachings which shown *removal of a portion of a substrate having a portion of the first communication thereon*. The Fig. 12 mark extraction is clearly illustrative of internal software processing which fails to disclose or suggest any teachings directed toward removal of a portion of a substrate. Applicant respectfully requests identification by reference number of the Cass teachings alleged to disclose or suggest the substrate.

Referring to claim 9, the Action alleges that the claimed limitations are well known in the art of book printing and it would have been obvious to implement these features in Cass that produces hard copy documents. Applicant disagrees with the combination of Cass and Edens and the rejection of claim 9 is improper.

In particular, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8<sup>th</sup> ed.).

There is no motivation to combine the reference teachings and the rejection of claim 9 is improper for at least this reason.

The Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be through and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. The *Lee* Court stated that the Examiner's conclusory statements in the *Lee* case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and can not be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from the bald conclusory statements of the Examiner which are insufficient for proper motivation as set forth by the Federal Circuit. The Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims but must set forth objective rationale on which it relied.

More specifically, referring to page 8 of the Action in support of the combination of teachings of Edens with teachings of Cass, it is stated that it would have been obvious to modify Cass since it was common to use such features of Edens in document processing. Applicants submit that statements set forth in the present Office Action are akin to the alleged improper motivation discussed *In re Lee* and accordingly are insufficient to combine the reference teachings.

In particular, there is absolutely no evidence of record to support the subjective conclusory statement of the Examiner. The only motivation presented in the Office Action is based upon the Examiner's subjective belief or unknown authority which is insufficient as clearly held by the applicable authority. As set

forth by the Federal Circuit, there is no motivation and the Office Action has failed to establish a prima facie case of obviousness and accordingly the 103 rejection is improper.

Applicants submits that the alleged motivation presented by the Examiner would open the door to combinations of any art which are not directed towards the concerns of the reference being modified with absolutely no evidence or objective support apart from the bald, conclusory statements of the Examiner. *This is contrary to the authority of the Federal Circuit that motivation may not be based upon the subjective belief of the Examiner or unknown authority.*

Cass is directed towards *a paper-based user interface with extraction of user marks from a document to identify a user's intentions* and is not directed to or concerned with book printing or finishing. Without proper motivation, the only motivation improperly results from Applicant's application. However, the motivation for forming the combination must be something other than hindsight reconstruction based on using Applicant's invention as a road map for such a combination. *See, e.g., Interconnect Planning Corp. v. Feil*, 227 USPQ 543, 551 (Fed. Cir. 1985); *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990). The 103 rejection is improper for at least this reason.

Finally, the Examiner is reminded that claims are analyzed in the context of the *combination of the various separately stated limitations, and not with respect to the limitations individually.*

Referring to new claim 21, the Examiner relies upon the teachings of col. 11, lines 15-25 of Cass in support of the rejection. Such teachings merely recite that if the marked document instance includes a code, then the code may be utilized to identify and extract the corresponding original/reference document stored in the database and which corresponds to the marked document instance. It is clear that the code of col. 11 identifies the original/reference document and is not a respective identifier code of the second communication comprising a changed communication as claimed. Cass fails to disclose or suggest storage of a changed (i.e., second) communication within a database or storage of a respective identifier of the changed second communication in the database as claimed. Positively-recited limitations of claim 21 are not shown nor suggested by the art and claim 21 is allowable for at least this reason.

Referring to new claim 22, Cass is silent regarding storage of a changed communication within a database, or the storage of an identifier of the changed communication within the database. It follows that Cass is also silent regarding details of how and/or when an identifier of the changed communication is stored in the database. Cass is clearly deficient with respect to teaching or suggesting *automatic* storage of the respective identifier code *when the changed communication is stored in the database*. Numerous limitations of claim 22 are not shown nor suggested by claim 22 and claim 22 is allowable for at least this reason.

Referring to claim 7, numerous limitations are not shown nor suggested by Cass and the rejection of claim 7 over Cass is clearly erroneous. Initially, Cass fails to disclose or suggest the *database having multiple versions of a document having a common document specific code and different version specific codes*. The identified teachings in col. 11 merely recite if a code is provided on the marked document instance then the code may be utilized to identify the reference document. There are no multiple versions of a document taught or suggested in Cass or that the multiple versions have a common code and different version specific codes as claimed. If claim 7 is not allowed and in accordance with the MPEP and CFR, Applicant respectfully requests identification in a non-final action of specific columns, lines, and reference numbers of the Cass teachings which are alleged to disclose both the common identifier code and the different version specific codes as claimed so Applicant may appropriately respond.

Claim 7 further recites forming a hard copy of a document having a *common document specific code* provided thereon *and a version specific code* provided thereon. Inasmuch as Cass fails to teach or suggest the database having the multiple versions of the document having the common document specific code and the version specific codes, Cass also fails to teach or suggest the formation of a hard copy of a document having both the common document specific code and version specific code provided thereon. Claim 7 is allowable for this additional reason.

Cass fails to disclose or suggest providing the document specific code and version specific code to a processor and the processor being configured to extract at least a portion of a second version of a document. Cass is directed towards indexing and extraction of an original/reference document stored in the database

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which is compared with the marked document instance in an effort to extract marks introduced by a user to obtain the intent of the user in furtherance of the paper based user interface. Cass is devoid of multiple versions of a document having a common document specific code and version specific code as claimed. Numerous limitations of claim 7 are not shown nor suggested by Cass and claim 7 is allowable for at least this reason.

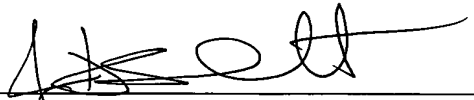
The claims which depend from independent claim 7 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Applicant hereby adds new claims 23-25 which correspond to and include limitations of respective ones of previously pending dependent claims 10-12 and the respective base claim 7. New claims 23-25 are believed to be allowable in view of the indication in the Office Action that claims 10-12 recite patentable subject matter. Allowance of new claims 23-25 is respectfully requested.

Applicant requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,  
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